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**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/730,814 12/06/00 KYLE

D 332.1114

EXAMINER

HM12/1002

DAVIDSON DAVIDSON & KAPPEL LLC  
485 SEVENTH AVENUE 14TH FLOOR  
NEW YORK NY 10018

BARTS, S

ART UNIT

PAPER NUMBER

1621

DATE MAILED:

10/02/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/730,814

Applicant(s)

KYLE ET AL.

Examiner

Samuel A Barts

Art Unit

1621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 55.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of the elected species 1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-dibutylamino ethyl in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the search of the entire genus would not be a serious burden to examiner. This is not found persuasive because the applicant has incorrectly assumed that the examiner would have to only search the recited species in claim 6. This assumption is incorrect. The claimed invention, including the broadest claims, will have to be searched. Claim 1 is the broadest claim and clearly reads on thousands of species. The exhaustive search of this claim and the other claims would be a serious burden to the examiner.

The requirement is still deemed proper and is therefore made FINAL.

2. The disclosure is objected to because of the following informalities: The specification is objected to because some named compounds do not agree with the corresponding formulas. 1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-dibutylamino ethyl is connected with formula 4 on page 9. The correct name of the structure labeled "4" in the specification is 1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-3-dibutylamino *propyl*. In the example, on page 10 of the specification, it states that compound "4" is made from compound "3". Note that compound "3" has three carbons between the nitrogen atoms. The resulting

compound made from compound "3" would also have three carbons between the nitrogen atoms. The structure labeled "4" does have three carbons but the named carbon does not reflect the same. Correction is required.

1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-diethylamino ethyl also appears to be wrongly named. Note the compound on page 9 of the specification labeled "6". The two alkyl substituents on the nitrogen atom are methyl in the formula. However, in the named compound the alkyl substituents are called ethyl.

Appropriate correction is required.

***Allowable Subject Matter***

3. The elected species was found allowable. The compounds searched were 1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-dibutylamino propyl and 1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-dibutylamino ethyl. Both were found allowable over the prior art. The search was extended to determine patentability of claims.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because in the last line of claim 1 the upper case letter "N" is used to represent the lower case "n" in the formula of the claim. Correction is required.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ajisawa et al (GB 2,006,196).

Ajisawa discloses the named species (1-[1-benzyl-1-(2-phenyl-1-oxo-ethyl)-amino]-2-diethylamino ethyl) of claim 6. The claimed compound is disclosed in Ajisawa et al on page 5 in table 1 (compound number 9). The compounds of Ajisawa et al are pharmaceutical active compound for treating pain.

8. Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Ajisawa et al (GB 2,006,196).

Ajisawa discloses other species that anticipate the claimed invention.

For example, see compounds 1, 12, and 13 in Ajisawa et al on page 5 in table 1.

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ajisawa et al (GB 2,006,196).

Ajisawa et al teaches compounds which are useful for treating pain. Ajisawa et al discloses species that anticipate the claimed invention (see above rejections). The generic disclosure of Ajisawa et al also renders obvious the claimed invention. See for example the abstract. The genus overlaps with the instantly claimed invention. It would have been obvious, to one of ordinary skill in the art, to choose compounds within the generic teaching of Ajisawa et al with a reasonable expectation that the compounds would be useful for treating pain. A skill artisan would be motivated to choose different species within the genus in order to make other compounds useful for treating pain.


The disclosed species in Ajisawa et al (i.e. compounds in table 5; 1, 9, 12, 13) also render obvious compounds that are structurally similar. For example, adjacent homologues of the exemplified species would be obvious, even if not said homologues are not embraced by the generic description in Ajisawa. It would have been obvious to one of ordinary skill in the art to make structurally

similar compounds of the species disclosed in Ajisawa et al with a reasonable expectation that the compounds would be useful for treating pain. A skill artisan would be motivated to make structurally similar compounds to those disclosed in Ajisawa et al in order to make other compounds useful for treating pain.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel A Barts whose telephone number is 703-308-4630. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johan Richter can be reached on 308-1235. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Samuel A Barts  
Primary Examiner  
Art Unit 1621

s.b.  
October 1, 2001